



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,966	08/03/2001	Masuyo Horiguchi	045054-0145	8808

22428 7590 01/10/2008
FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

ADDY, THJUAN KNOWLIN

ART UNIT	PAPER NUMBER
----------	--------------

2614

MAIL DATE	DELIVERY MODE
-----------	---------------

01/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/920,966	Applicant(s) HORIGUCHI, MASUYO	
	Examiner Thjuan K. Addy	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-32, 43 and 45 is/are allowed.
- 6) ☒ Claim(s) 33-42 and 44 is/are rejected.
- 7) ☒ Claim(s) 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on October 24, 2007 has been entered. Claims 25, 26, 33, 34, 36, 39, 45, and 46 have been amended. Claims 1-24 have been cancelled. No claims have been added. Claims 25-46 are still pending in this application, with claims 25, 33, 34, and 39 being independent.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/2007 has been entered.

Allowable Subject Matter

3. Claim 46 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claims 25-32, 43, and 45 are allowed.
5. The following is an examiner's statement of reasons for allowance: The invention as now claimed is not disclosed nor rendered obvious in view of the prior art of

record. As to independent claim 25, the prior art of record fails to teach or suggest, alone or in combination, the recited foldable portable cellular phone, wherein, when the unanswered call that was initiated by one of the plurality of pre-registered calling parties was received while said foldable portable cellular phone was folded, one of the plurality of different sounds stored in the telephone directory memory that corresponds to the one of the plurality of pre-registered calling parties that initiated the unanswered call is output through operation of said key, whereby each of a plurality of different calling parties that respectively correspond to respective ones of the plurality of pre-registered calling parties may be identified by each of a plurality of different sounds being output in response to operation of said key. No prior art was found that discloses or teaches the limitations of claim 25.

6. Claims 26-32, 43, and 45 are dependent upon claim 25, therefore, claims 26-32, 43, and 45 are allowed.

7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 33-42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toba (US 6,438,392), in view of Watanabe et al. (US 6,125,264).
9. In regards to claims 33, 34, 37, 41, and 44, Toba discloses a method and portable phone (e.g., portable cellular phone, See Fig. 1) and method being constructed integrally of a main body (See Fig. 1 and body 1) with a speech function, a lid body (See Fig. 1 and cover section 2) foldable relative to said main body, and a screen (See Fig. 1 and Liquid Crystal Display (LCD) 6) to display operational contents, comprising: a control section (See Fig. 3 and control circuit 12) to store in a call history storing area in a storing unit call history information (for example, telephone number or an ID of the calling party, a timestamp, etc.) about an unanswered call that was received (See col. 5 lines 28-35); a key (See Fig. 3 and operation keys 4) operative to provide control signals to said control section to cause said control section to search said call history storing area in said control section and said telephone directory memory, said key being configured to be operated by a called party (e.g., user); wherein, when the unanswered call was received while said foldable portable cellular phone was folded, a sound (for example, the sound is providing by the vibrator 15 or the sounder 16, See Fig. 3) corresponding to a calling party of the unanswered call is output through operation of

said key (See col. 5 lines 21-35 and col. 5-6 lines 55-4). Toba, however, does not disclose a telephone information registering unit including a telephone directory memory in which a plurality of different sounds are stored so as to be associated with a corresponding plurality of pre-registered calling parties; upon a match resulting from said searching, cause to output one of said plurality of sounds which corresponds to a pre-registered calling party stored in said telephone directory memory; and whereby each of a plurality of different calling parties may be identified by each of a plurality of different sounds in response to operation of said key. Watanabe, however, does disclose a telephone information registering unit (See Fig. 1 and ROM 22) including a telephone directory memory (See Fig. 1 and RAM 23) in which a plurality of different sounds are stored so as to be associated with a corresponding plurality of pre-registered calling parties (See col. 3 lines 16-21, col. 3 lines 35-52, col. 5 lines 8-26, col. 5 lines 34-56, and col. 6 lines 1-21); upon a match resulting from said searching, cause to output one of said plurality of sounds which corresponds to a pre-registered calling party stored in said telephone directory memory (See col. 5 lines 8-26, col. 5 lines 34-56, and col. 5 lines 53-62); and whereby each of a plurality of different calling parties may be identified by each of a plurality of different sounds in response to operation of said key (See Fig. 1 and operation keyboard 25) (See col. 3 lines 53-57, col. 5 lines 8-26, col. 5 lines 34-56, and col. 6 lines 1-21). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate these features within the system, as a way of providing a signal receiving method, which includes the

steps of receiving a signal and informing a called party about the status of a call received.

10. In regards to claims 35, and 40, Toba discloses the portable phone, wherein said incoming call history information includes the name of a calling party (See col. 5 lines 28-35).

11. In regards to claim 36, Toba discloses all of claim 36 limitations, except the portable phone, wherein said control section is configured to cause to output one of said plurality of sounds corresponding to a second one of said pre-registered calling parties who called prior to a first one of said pre-registered calling parties in response to multiple successive operations of said key. Watanabe, however, does disclose wherein said control section is configured to cause to output one of said plurality of sounds corresponding to a second one of said pre-registered calling parties who called prior to a first one of said pre-registered calling parties in response to multiple successive operations of said key (See col. 3 lines 16-21, col. 3 lines 35-52, col. 5 lines 8-44, and col. 5 lines 53-62).

12. In regards to claim 38, Toba discloses all of claim 38 limitations, except the portable phone, wherein the controller is configured to cause generation of the sound, in response to operation of the key if the foldable body is folded. Watanabe, however, does disclose wherein the controller is configured to cause generation of the sound, in response to operation of the key (See col. 3 lines 35-52 and col. 5 lines 46-52).

13. In regards to claims 39 and 42, Toba discloses all of claims 39 and 42 limitations, except a portable phone, wherein vibration is employed in addition to said sounds.

Watanabe, however, does disclose wherein vibration is employed in addition to said sounds (See col. 7 lines 22-29).

14. In regards to claim 44, Toba and Watanabe disclose all of claim 44 limitations, except Toba does not disclose the portable phone, wherein, when m unanswered calls were received by said portable phone, m being a positive integer greater than one, and upon operation of the keypad m consecutive times by the called party, a sound corresponding to a calling party of the m unanswered calls that was received by said portable phone prior to any of the other $m-1$ unanswered calls, is output through operation of said key. Watanabe, however, does disclose wherein, when m unanswered calls were received by said portable phone, m being a positive integer greater than one, and upon operation of the keypad (See Fig. 1 and operation keyboard 25) m consecutive times by the called party, a sound corresponding to a calling party of the m unanswered calls that was received by said portable phone prior to any of the other $m-1$ unanswered calls, is output through operation of said key (See col. 3 lines 53-57, col. 5 lines 8-26, col. 5 lines 34-56, and col. 6 lines 1-21).

Response to Arguments

15. Applicant's arguments filed 10/24/2007 have been fully considered but they are not persuasive.

16. Applicant argues that, in regards to claims 33, 34, and 39, there is no teaching or suggestion in either Toba or Watanabe et al. as to a called party being able to select different sound to correspond to different calling parties, such that when the called

party's cellular phone is folded, the user can then determine who called him/her by selecting a button and hearing the sounds that emanate from the cellular phone that indicate who had called him/her. Applicant further argues that, in regards to claim 44, Watanabe does not disclose wherein, when m unanswered calls were received by said portable phone, m being a positive integer greater than one, and upon operation of the keypad m consecutive times by the called party, a sound corresponding to a calling party of the m unanswered calls that was received by said portable phone prior to any of the other $m-1$ unanswered calls, is output through operation of said key.

17. In response to Applicant's argument that , in regards to claims 33, 34, and 39, there is no teaching or suggestion in either Toba or Watanabe et al. as to a called party being able to select different sound to correspond to different calling parties, such that when the called party's cellular phone is folded, the user can then determine who called him/her by selecting a button and hearing the sounds that emanate from the cellular phone that indicate who had called him/her, Examiner would like to bring to Applicant's attention, that unlike claim 25, claims 33, 34, and 39 do not recite wherein, when the unanswered call that was initiated by one of the plurality of pre-registered calling parties was received while said foldable portable cellular phone was folded, one of the plurality of different sounds stored in the telephone directory memory that corresponds to the one of the plurality of pre-registered calling parties that initiated the unanswered call is output through operation of said key, whereby each of a plurality of different calling parties that respectively correspond to respective ones of the plurality of pre-registered calling parties may be identified by each of a plurality of different sounds

being output in response to operation of said key. There is no indication (except for in the preamble of claim 33), that the portable phone is foldable, and there is no indication in claims 33 and 39, that the calling parties are pre-registered.

18. In response to Applicant's argument that in regards to claim 44, Watanabe does not disclose wherein, when m unanswered calls were received by said portable phone, m being a positive integer greater than one, and upon operation of the keypad m consecutive times by the called party, a sound corresponding to a calling party of the m unanswered calls that was received by said portable phone prior to any of the other $m-1$ unanswered calls, is output through operation of said key, Examiner respectfully disagrees. Watanabe discloses wherein, when m unanswered calls were received by said portable phone, m being a positive integer greater than one, and upon operation of the keypad (See Fig. 1 and operation keyboard 25) m consecutive times by the called party, a sound corresponding to a calling party of the m unanswered calls that was received by said portable phone prior to any of the other $m-1$ unanswered calls, is output through operation of said key (See col. 3 lines 53-57, col. 5 lines 8-26, col. 5 lines 34-56, and col. 6 lines 1-21).

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thjuan K. Addy whose telephone number is (571) 272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.
20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thjuan K. Addy
Patent Examiner
AU 2614